

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Confirmation No.: 4980

Filed: 29 March 2001

For: METHOD FOR MAKING A STEM WEB

Remarks

The Final Office Action mailed 6 February 2004 has been received and reviewed. Applicants are submitting proposed revisions to claim 42. The pending claims remain 11, 13-15, 21-32, and 34-58. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowable Claims

Applicants thank the Examiner for notification to the effect that claims 32, and 34-40 are allowable and that claim 14 would be allowable if rewritten in independent form.

Objected Claims

Applicants have proposed an amendment to claim 42 as suggested by the Examiner. Entry and consideration of the proposed amendment are respectfully requested. Applicants respectfully submit that entry of the proposed amendment addresses the Examiner's objection to claim 42.

The 35 U.S.C. §112, First Paragraph, Rejections**Written Description**

Claims 52, 53, and 54 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner alleged that there is no disclosure of entangling the polymeric region with the fibrous surface where the web includes a film layer, an elastic film layer, or an elastic web.

Applicants traversed this rejection in the previous response and continue to traverse it here. As discussed, claims 52-54 depend from claim 50 and further describe the nonwoven web. These claims utilize the open-ended transitional language "comprises" and thus do not exclude additional unrecited elements (*see* M.P.E.P. § 2111.03). As a result, these claims indicate that

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the nonwoven web may include, e.g., a film layer or an elastic film layer, or the nonwoven web may be an elastic web. The claims do not recite that the nonwoven web is a film layer, an elastic film layer, or an elastic web as asserted in the Office Action. Rather, the claims merely recite that the nonwoven web "comprises" (i.e., may include) a film layer (claim 52), an elastic film layer (claim 53), and that the web may be an elastic web (claim 54). Webs with the recited constructions are supported in the Specification and claims as originally filed (*see, e.g.*, page 2, lines 21-26; page 5, line 23 - page 6, line 2; Example Substrates A-G; and original claims 6-7).

Applicants submit that this rejection does not meet the requirements for a proper written description rejection. The proper standard is discussed in the following section of the MPEP.

"The examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed."

MPEP § 2163(III)(A) p. 2100-170.

The reasoning provided for this Written Description rejection is that "[t]he only disclosure in the Specification where the polymeric region is 'entangled with the fibrous major surface' is when the nonwoven web is 'orange construction paper' (Example 13 on pages 17-18 with substrate G on page 11). There is no disclosure of entangling the polymeric region with the fibrous surface where the web is a film layer, an elastic film layer, or an elastic web." Office Action, p. 3.

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The support offered for this rejection is wholly inadequate when compared with the standards for a proper *prima facie* written description rejection. No discussion is provided as to why one of skill in the art would not recognize that Applicants had possession of the claimed invention at the time of filing. Rather, the rejection essentially restates a portion of the disclosure in the application and then asserts that claims 52 and 53 are not enabled.

Furthermore, the rejection appears to be based on a misunderstanding as to the scope of the claims. As noted above, the claims do not "recite that the nonwoven web is a film layer, an elastic film layer, or an elastic web" as asserted in the Office Action. Rather, the claims merely recite that the nonwoven web "comprises" (i.e., may include) a film layer (claim 52), an elastic film layer (claim 53), and that the web may be an elastic web (claim 54).

In the absence of any reasoned discussion as to why one of skill in the art would not recognize that Applicants possessed the claimed invention, it is impossible for the rejection to establish "by a preponderance of the evidence" that Applicants did not possess the claimed invention.

For at least the reasons presented above, Applicants submit that the 35 U.S.C. § 112, first paragraph written description rejection of claims 52-54 is improper. Reconsideration and withdrawal are requested.

Enablement

Claims 52 and 53 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner asserts that "[t]here is no disclosure in the Specification of the nonwoven web containing a fibrous surface layer and a film or elastic film layer. Therefore, there is no disclosure that would enable one skilled in the art to entangle a polymeric region with a fibrous surface of a nonwoven web where the web is a film or elastic film (which do not have fibrous surfaces)." Office Action, pp. 15-16.

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Applicants traversed this rejection in the previous response and continue to traverse it here. As discussed in the previous response (and above with respect to the written description rejection), the transitional language of claims 52 and 53 does not exclude additional, unrecited components from the claim. That is, the rejected claims simply identify one element of the nonwoven web as a film layer (claim 52) or an elastic film layer (claim 53). The claims do not recite that the nonwoven web is a film layer or an elastic film layer as asserted in the Office Action.

In addition, the specification does indicate that the substrates used in connection with the present invention may be "a composite of various fibers and films." Such composite films are known in the art. In fact, one of the references cited by the Examiner in support of one of the obviousness rejections shows one example of a substrate that is a nonwoven web with a film layer. *See, e.g.,* WO 96/04812 (King et al.), pp. 7-8 and FIG. 1. In other words, one of skill in the art would understand how to make a nonwoven web that includes a film layer or an elastic film layer as recited in claims 52 and 53 as demonstrated by a reference cited by the Examiner.

Furthermore, this rejection provides no discussion with respect to a critical portion of enablement, i.e., whether one of ordinary skill in the art would be able to make the claimed invention without undue experimentation. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *U.S. v. Telectronics, Inc.*, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The asserted rejection, however, provides no such discussion on enablement, but instead relies on the asserted limitations of one of the working examples described in the specification.

The MPEP itself, however, notes that "[t]he presence of only one working example should never be the sole reason for rejecting claims as being broader than the enabling disclosure, even though it is a factor to be considered along with all the other factors. To make a valid rejection, one must evaluate all the facts and evidence and state why one would not expect to be able to extrapolate that one example across the entire scope of the claims." MPEP § 2164.02,

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p. 2100-181. The asserted rejection, however, relies solely on the Examiner's interpretation of one working example.

For at least the above reasons, Applicants respectfully submit that the rejection of claims 52 and 53 for lack of enablement is improper. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

The 35 U.S.C. §102 Rejections

Claims 11, 13, 22, 25, 26-31, 41, 42, 45, 48-52, 55, and 58

The Examiner maintained the rejection of claims 11, 13, 22, 25, 26-31, 41, 42, 45, 48-52, 55, and 58 under 35 U.S.C. §102(b) as being anticipated by Murasaki (U.S. Patent No. 5,643,651). Applicants traverse this rejection for at least the following reasons.

To anticipate a claim, each and every element of the claim must be taught by the cited reference (see M.P.E.P. §2131). Independent claim 11 recites providing a plurality of discrete quantities of a polymeric material on the web at a temperature above its softening point, wherein a plurality of discrete polymeric regions are formed on the web; and forming a plurality of stems in each discrete polymeric region of the plurality of discrete polymeric regions.

Independent claim 42 recites providing a web construction comprising a web and a plurality of discrete polymeric regions on a first major surface of the web, wherein each discrete polymeric region comprises a discrete quantity of polymeric material; providing a tool comprising a plurality of stem-forming holes formed in a surface of the tool; and pressing each discrete polymeric region of the plurality of discrete polymeric regions on the first major surface of the web against the surface of the tool when the polymeric material of each discrete polymeric region is above its softening point, wherein a portion of the polymeric material enters the stem-forming holes.

Claim 50 recites providing at least one discrete quantity of polymeric material on a fibrous major surface of a nonwoven web, wherein the at least one discrete quantity of polymeric

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material forms at least one discrete polymeric region entangled with the fibrous major surface; and forming a plurality of stems in the at least one discrete polymeric region.

Murasaki, on the other hand, teaches a molded surface fastener in which a multiplicity of male engaging elements are integrally molded on a substrate sheet. To produce the fastener, molten resin is passed through a coarse sheet-like connector having spaces enough for the molten resin to pass, so that the substrate sheet is "divided into a desired number and the male engaging element[s] are molded simultaneously, and at the same time, the connector is embedded in the substrate sheet with the connector connecting the divided substrate sheets." (Col. 1, lines 52-59, emphasis added). "The sheet-like connector to be used in this invention must have over its entire area adequate open spaces through which molten resin can easily be passed." (Col. 2, lines 19-21, emphasis added).

In contrast, the rejected claims recite forming or providing one or more discrete polymeric regions: on the web (claim 11); on a first major surface of the web (claim 42); or entangled with a fibrous major surface of the nonwoven web (claim 50). Forming the regions on the web is not synonymous with encapsulating a portion of the web within the resin as taught by Murasaki.

Moreover, Murasaki teaches the formation of male engaging elements simultaneously with the joining or encapsulating of the web in the resin. The rejected claims, on the other hand, recite forming the discrete polymeric regions on the web (claim 11); providing a web construction comprising the discrete polymeric regions on a first major surface of the web (claim 42); or forming at least one discrete polymeric region entangled with a fibrous major surface of the web (claim 50). With the polymeric regions in place on the webs, the plurality of stems are formed therein.

For at least these reasons, Applicants submit that Murasaki fails to teach each and every element of independent claims 1, 42, and 50.

It is further submitted that claims 13, 22, 25, 26-31, 41, 45, 48-49, 51-52, and 55 are also novel, not only because of their dependence, but also in view of the particular subject matter

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recited in these claims. For example, claims 26 and 27 recite relative coverage of the discrete polymeric regions. Contrary to the assertions of the Office Action, Murasaki does not identify the claimed relative coverage (or any particular coverage, for that matter) in Figures 4 and 5. Further, for example, there is no teaching identified of stems that are angled to a localized plane of the web (see e.g., claims 29-31). In fact, Figure 4 of Murasaki, which the Office Action cites in support of the rejection, show only perpendicular hook elements.

Claim 52 recites that the nonwoven web includes a film layer. The rejection includes no discussion as to where or how Murasaki discloses the combination of a nonwoven web and a film layer as recited in claim 52.

With respect to independent claim 58, Applicants note that the claim recites "forming a plurality of stems in each discrete polymeric region of the plurality of discrete polymeric regions after forming the plurality of discrete polymeric regions." Murasaki, in contrast, teaches forming the discrete polymeric regions and the features therein "at the same time" – not sequentially as asserted in the Office Action. *See, e.g.,* Murasaki, col. 5, lines 53-65.

Reconsideration and withdrawal of the rejection of claims 11, 13, 22, 25, 26-31, 41, 42, 45, 48-52, and 55 are, therefore, requested.

Claims 11, 13, 22, 24, 28, and 41

The Examiner maintained the rejection of claims 11, 13, 22, 24, 28, and 41 under 35 U.S.C. §102(b) as being anticipated by Hasegawa et al. (JP 8-187113). Applicants traverse this rejection for at least the following reasons.

Claim 11 (from which claims 13, 22, 24, 26-28, and 41 depend) recites a method of making a web material having a plurality of stems extending from discrete regions of the web. The method includes providing a plurality of discrete quantities of a polymeric material on the web at a temperature above its softening point, wherein a plurality of discrete polymeric regions are formed on the web.

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Hasegawa et al., on the other hand, describes an elastic section (reference numeral 2 in the figures) that could be considered a "web," and fastening sections (reference numeral 1). The fastening sections are, however, formed only along the peripheral edges of the elastic section, not "on the web" as claimed. Stated alternatively, there is no plurality of stems extending from discrete regions on the web as claimed. Rather, stems extend from separate sections attached to peripheral edges of the web.

Because anticipation requires that the cited reference teach each and every limitation of the rejected claim, Applicants submit that Hasegawa et al. fails to anticipate claim 11. Moreover, claims 13, 22, 24, 26-28, and 41 are also novel not only in view of their dependence, but also because of the particular subject matter recited therein. For example, the Office Action has not identified any specific teaching in Hasegawa et al. of the claimed coverages recited in claims 26-27. Rather, the Office Action merely refers to the figures in rejecting these claims. Yet, the figures do not illustrate the fastening sections covering a portion of the elastic section.

For at least these reasons, Applicants request reconsideration and withdrawal of the rejection of claims 11, 13, 22, 24, 26-28, and 41.

The 35 U.S.C. §103 Rejections

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

M.P.E.P. § 2143.

Murasaki in view of Kennedy et al.

The Examiner maintained the rejection of claims 21, 23, 24, 44, 47, 46, and 50-55 under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) in view of

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Kennedy et al. (U.S. Patent No. 5,260,015). In addition, independent claim 58 was also rejected over Murasaki in view of Kennedy et al. Applicants traverse this rejection for at least the following reasons.

Claims 21, 23, and 24 depend from claim 11; claims 44, 46, and 47 depend from claim 42; and claims 51 -55 depend from claim 50. As described above, Murasaki fails to teach, or even suggest, each and every element of these independent claims (e.g., forming/providing the discrete polymeric regions either on the web or entangled with a fibrous major surface of the web; and forming the stems separately). There is nothing identified within Kennedy et al. that remedies this deficiency.

Moreover, Applicants submit that the Office Action provides no legally sufficient motivation to combine the teachings of Murasaki with those of Kennedy et al. For example, Murasaki states that "[t]he sheet-like connector to be used in this invention must have over its entire area adequate open spaces through which molten resin can easily be passed." (Col. 2, lines 19-21, emphasis added). Without the openings, the resin could not flow sufficiently to encase the connector during fastener formation. However, Kennedy et al. specifically states that, with the present invention, a process "controls the distribution of plastic into the backing material to a degree necessary to firmly hold the backing material to the base of the hook sheet but does not encase the backing to destroy it's aesthetic characteristics as a functioning backing material to modify the back surface of the fastener." (Col. 2, lines 34-40).

Thus, Applicants submit that one skilled in the art would not be motivated to combine the teachings of Murasaki with those of Kennedy et al. because Murasaki requires complete resin flow through the web while Kennedy et al. seeks to prevent it. In fact, if Murasaki were modified as proposed by the Office Action, Applicants submit that it would render Murasaki unsatisfactory for its intended purpose, e.g., Murasaki requires generally unimpeded flow through the web. Where a proposed modification would "render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (M.P.E.P. § 2143.01).

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With respect to claims 52 and 53, Applicants note that Murasaki does not disclose the combination of a nonwoven web with a film layer. No assertions are provided in connection with the obviousness rejection of claims 52 and 53 as to why one of ordinary skill in the art would modify the teachings of Murasaki to use a nonwoven web that includes a film layer as recited in claims 52 and 53. For at least that reason, Applicants submit that a proper *prima facie* case of obviousness has not been established with respect to claims 52 and 53.

Furthermore, with respect to independent claim 58 presented in the previous response, Applicants note that no discussion is provided to support the rejection of claim 58 over Murasaki in view of Kennedy et al. As noted above in connection with the anticipation rejection of claim 58, Murasaki does not teach all of the elements of claim 58. Furthermore, the obviousness rejection of claim 58 identifies no motivation or suggestion to modify the teachings of Murasaki to reach the invention recited in claim 58. A proper *prima facie* case of obviousness with respect to claim 58 would, however, require identification of some motivation or suggestion to modify the cited references to reach the invention of claim 58.

For at least these reasons, reconsideration and withdrawal of claims 21, 23, 24, 44, 47, 46, 50-55, and 58 as being unpatentable over Murasaki in view of Kennedy et al. are respectfully requested.

Murasaki (optionally in view of Kennedy et al.) in view of Morris and/or Melbye

The Examiner maintained the rejection of claims 15, 43, and 57 under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) (optionally in view of Kennedy et al. (U.S. Patent No. 5,260,015) as applied to claims 11, 42, and 50 above, and further in view of Morris (U.S. Patent No. 5,792,411) and/or Melbye et al. (U.S. Patent No. 5,077,870).

Applicants traverse this rejection for at least the following reasons.

Claims 15, 43, and 57 depend from claims 11, 42, and 50, respectively, and, as such, include all the recitations of these respective independent base claims. As described above, Murasaki (with or without Kennedy et al.) fails to teach, or even suggest, each and every element

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of these independent claims (e.g., forming/providing the discrete polymeric regions either on the web or entangled with a fibrous major surface of the web; and forming the stems separately).

There is nothing identified within Morris and/or Melbye et al. that remedies these deficiencies as these documents are relied on solely to teach the deformation of stems with a heated surface to produce an enlarged end on the stems.

For at least these reasons, Applicants submit that the identified combination of documents fails to teach or suggest each and every limitation of the rejected claims. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

Murasaki Optionally in view of Reich et al.

The Examiner maintained the rejection of claims 24, 26, 27, 47, 53, and 54 under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) (and further optionally in view of Reich et al. (U.S. Patent No. 5,456,660)). Applicants traverse this rejection for at least the following reasons.

Claims 24, 26, and 27; claim 47; and claims 53-54 depend from claims 11, 42, and 50, respectively, and, as such, include all the recitations of these respective independent base claims. As described above, Murasaki fails to teach, or even suggest, each and every element of these independent claims (e.g., forming/providing the discrete polymeric regions either on the web or entangled with a fibrous major surface of the web; and forming the stems separately).

Moreover, Applicants note that Murasaki fails to teach or suggest the specific elements of these rejected dependent claims. For example, there is no identification of the claimed coverages of claims 26 and 27 in Murasaki.

Applicants note that Reich et al. has been cited as teaching or suggesting "an example in the art of an elastic substrate for fastener material." Applicants note that no particular portion of Reich et al. is cited as supporting the assertions made in the Office Action. In fact, a review of the teachings of Reich et al. shows that it provides no disclosure relating to the nature of the

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substrate of the hook fastener pad 30. As a result, the assertions made with respect to the teachings of Reich et al. are not supported by the reference itself.

For at least these reasons, Applicants submit that Murasaki (in view of Reich et al. or not) fails to teach or suggest each and every limitation of the rejected claims. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

Murasaki in view of Morris

The Examiner maintained the rejection of claims 29-31 under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) and further in view of Morris (U.S. Patent No. 5,792,411).

Claims 29-31 depend from claim 11 and, as such, include all the recitations of that claim. As described above, Murasaki fails to teach, or even suggest, each and every element of claim 11 (e.g., forming the discrete polymeric regions on the web and forming stems in discrete polymeric regions). There is nothing identified within Morris that remedies these deficiencies. Accordingly, reconsideration and withdrawal of the rejection of claims 29-31 over Murasaki in view of Morris are respectfully requested.

Murasaki (optionally in view of Kennedy et al.) in view of Shimizu

The Examiner rejected claim 56 under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) (optionally in view of Kennedy et al. (U.S. Patent No. 5,260,015)) as applied to claim 50 above and further in view of Shimizu (U.S. Patent No. 4,732,631). Applicants traverse this rejection for at least the following reasons.

Claim 56 depends from claim 50 and, as such, includes all the recitations of claim 50. As described above, Murasaki (with or without Kennedy et al.) fails to teach, or even suggest, each and every element of this independent claim (e.g., forming at least one discrete polymeric region entangled with the fibrous major surface of the web, and forming the stems separately). There is

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nothing identified within Shimizu that remedies these deficiencies. Rather, Shimizu is identified only for the general configuration of the fasteners on the release sheet.

For at least these reasons, Applicants submit that the combination of Murasaki in view of Shimizu fails to teach or suggest each and every limitation of claim 56.

Applicants further submit that the Office Action fails to identify any motivation to combine the teachings of Murasaki with Shimizu that can support a *prima facie* case of obviousness. For example, Murasaki is directed to a molded surface fastener having male engaging members integrally molded on one surface of a substrate sheet. Shimizu, on the other hand, is directed to forming a plurality of individual fastener pieces on a release sheet where each of the fastener pieces is fused along its peripheral edge, i.e., Shimizu does not integrally attach its fastener elements to a substrate, but rather produces pieces that are easily removed from the substrate. Thus, there is no motivation identified to combine the teachings of these documents as asserted by the Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 56 over Murasaki in view of Shimizu are requested.

Murasaki (optionally in view of Kennedy et al.) in view of Matsuda and/or King et al.

The Examiner maintained the rejection of claims 24, 47, 53, and 54 under 35 U.S.C. §103(a) as being unpatentable over Murasaki (U.S. Patent No. 5,643,651) (optionally in view of Kennedy et al. (U.S. Patent No. 5,260,015)) as applied to claims 11, 42, and 50 above and further in view of Matsuda (EP 0233364) and/or King et al. (WO 96/04812). Applicants traverse this rejection for at least the following reasons.

Claims 24, 47, and 53-54 depend from claims 11, 42, and 50, respectively, and, as such, include all the recitations of these respective independent base claims. As described above, Murasaki in view of Kennedy et al. fails to teach, or even suggest, each and every element of these independent claims (e.g., forming/providing the discrete polymeric regions either on the web or entangled with a fibrous major surface of the web; and forming the stems separately).

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There is nothing identified within Matsuda and/or King et al. that remedies these deficiencies. Rather, Matsuda and/or King et al. are relied on solely to teach that loop materials are "well known to be elastic materials." (Office Action, page 13, paragraph 21). The references do not teach, nor is any assertion made, that Matsuda or King et al. teach providing discrete polymeric regions and forming stems therein can be accomplished on an elastic substrate.

For at least these reasons, Applicants submit that the combination of identified documents fails to teach or suggest each and every limitation of claims 24, 47, and 53-54. Reconsideration and withdrawal of this rejection of claims 24, 47, and 53-54 are, therefore, respectfully requested.

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Summary

It is respectfully submitted that the pending claims 11, 13-15, 21-32, and 34-58 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6th day of July, 2004, at 2:07 p.m. (Central Time).

By:

Rachel Gagliardi Gebhardt

Name:

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